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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/076,049	02/13/2002	Osamu Nabeta	M1971-107	8629

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EXAMINER

DOE, JANIS L

ART UNIT	PAPER NUMBER
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1756

DATE MAILED: 11/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

10/076,049

Applicant(s)

NABETA ET AL.

Examiner

Janis L. Dote

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1756

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 18 October 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 18 October 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached, paragraph 1.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached, paragraph 2.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-4, 6-11, and 13-24.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____.

Janis L. Dote
JANIS L. DOTE
PRIMARY EXAMINER
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1700

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Attachment to advisory action

1. The proposed amendments to claims 6 and 13, changing the phrase "stretched with a tension of 50 N/cm per unit width of said photosensitive body" to -- stretched over the rollers with a tension of 50 N applied across the width of said photosensitive body -- (emphasis added) raise new issues that would require further consideration and/or search, because the tension of "50 N applied across the width . . ." recited in the proposed amendments was not present in the claims when the final rejection was mailed, nor was it ever present in the claims.

The proposed amendments also raise a rejection under 35 U.S.C. 112, second paragraph, for lack of unambiguous antecedent basis for "the rollers" in the phrase "stretched over the rollers." Instant claims 6 and 13 do not previously recite the presence of rollers or that the photosensitive body is stretched over rollers. It is not clear whether "the rollers" refer to the "plurality or rollers" recited latter in the claims or to other rollers.

The proposed amendments further raise a rejection under 35 USC 112, first paragraph, for lack an adequate description of said limitation in the originally filed specification. The originally filed specification discloses that the "endless

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flexible single layer photosensitive body" is stretched with a "tension of 50 N/cm per unit length of the width of the photosensitive body" over a plurality of cylindrical rollers. Originally filed specification, page 12, line 4-5, and page 13, line 12-13. The originally filed specification at page 9, lines 17-19, discloses that the belt photosensitive body must have "a tension between the rollers of 50 N/cm or greater per unit length of the width of the belt photosensitive body" (emphasis added). In other words, the belt photosensitive body is stretched with a tension of "50 N/cm per unit length of the width" of the body between rollers, not across the length of the roller as implied by the phrase "a tension . . . applied across the width" of the photosensitive body as recited in the proposed amendments. The originally filed specification does not disclose a tension of "50 N applied across the width" of the photosensitive body, as recited in the proposed amendments to claims 6 and 13.

Applicants' attorney in the amendment filed after the final rejection on Oct. 18, 2004, states that one of ordinary skill in the art would understand "50 N/cm or greater per unit length of the width of the photosensitive body" to merely represent "a force of 50 N acting in tension." Applicants assert that "one of ordinary skill in the art would have understood the

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disclosure to merely define the tension force expressed in Newtons (N) per a metric unit, expressed in centimeters (cm), i.e., 'a tension of 50 N [per] cm or greater per unit length of the width of the photosensitive body.'"

However, the proposed amendments to claims 6 and 13 do not express the tension as a "force per a metric unit," but merely express the tension as a force, i.e., N. Furthermore, there is no evidence on the present record to show that the tension of "50 N/cm per unit length of the width of the photosensitive body" represents a tension of "50 N applied across the width" of the body as asserted by applicants. The definition in Webster's Third New International Dictionary, 1993, quoted by applicants does not disclose how the "tension" of a belt is determined, nor does the definition disclose how "tension" is expressed, e.g., units of force or units of force per unit length.

The proposed amendments to the paragraphs beginning at page 9, line 15, page 11, line 12, page 13, line 10, and page 66, line 18, of the specification, changing the phrase "tension . . . of 50 N/cm or greater per unit length of the width" to -- tension . . . of 50 N or greater --, raise the issue of new matter under 35 USC 132 for the reasons discussed above.

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The proposed amendment to the paragraph beginning at page 58, line 18, of the specification, changing the phrase "load of 50 N/cm per unit length of the width" to -- load of 50 N --, raises the issue of new matter under 35 USC 132 for the reasons discussed above.

The proposed amendment to the paragraphs beginning at page 65, line 25, of the specification, changing the phrase "50 N/cm or greater per unit length of the width" to -- 50 N --, raises the issue of new matter under 35 USC 132 for the reasons discussed above.

The proposed amendments to the paragraph beginning at page 65, line 2, of the specification, and the tables at pages 60, 61, and 64, changing the unit of tension from "N/cm" to - N --, also raise the issue of new matter under 35 USC 132. There is no evidence on the present record to show that the originally reported values of tension expressed as "N/cm" are equivalent to values of tension expressed as "N."

2. The examiner's refusal to enter the proposed amendments filed after the final rejection on Oct. 18, 2004, renders applicants' arguments moot. In addition, applicants' arguments that the proposed amendments do not raise the issue of new matter have been addressed in paragraph 1 above.